



S.S.N. 09/724,726
HADLACZKY *et al.*
ELECTION

Distinctness

The Examiner urges that IV, VI and VIII are unrelated as having different starting materials, different method steps, and different end products. This characterization is incorrect. It is respectfully submitted that Groups VIII and IV are related as a genus/species, and that Groups VIII and VI are related as a genus/species. Group VI is not properly restrictable from Group VIII, and Group IV is not properly restrictable from Group VIII. Therefore, Groups IV, VI and VIII are not properly restrictable.

Group IV

Group IV is directed to a method for producing a transgenic plant by introducing a SATAC into a protoplast; and producing a transgenic plant therefrom. A protoplast is a plant cell from which the cell wall is removed. Hence group IV is directed to a method for producing a transgenic plant by introducing a SATAC into a plant cell.

Group VI

Group VI is directed to a method for producing a transgenic plant by
introducing a DNA fragment into a first cell, wherein the DNA
fragment comprises a selectable marker;
growing the cell under selective conditions to produce cells that
have incorporated the DNA fragment into their genomic DNA; and
selecting a cell that comprises a satellite artificial chromosome
(SATAC); and
isolating the SATAC and introducing it into a plant cell, and
producing a transgenic plant.

Hence group VI is directed to a method for producing a transgenic plant by introducing SATAC into a plant cell. Group VI claims include the steps by which the SATAC is made.

Group VIII

Group VIII is directed to a method for producing a transgenic plant by introducing a satellite artificial chromosome (SATAC) into a plant cell; and culturing the cell under conditions whereby a plant is generated.



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Hence group VIII is directed to a method for producing a transgenic plant by introducing SATAC into a plant cell.

Groups VIII and IV

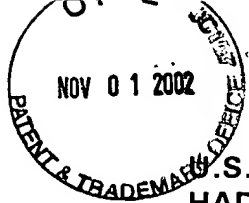
As noted, Group VIII is directed to a method for producing a transgenic plant by introducing a SATAC into a plant cell; and producing a transgenic plant therefrom. Group IV is directed to a method for producing a transgenic plant by introducing a SATAC into a protoplast; and producing a transgenic plant therefrom. Protoplast is a plant cell. Thus, Group IV is a species of the genus encompassed by group VIII. Therefore, Group VIII and Group IV are not independent or distinct.

If the claims are restricted into these two groups, applicant ultimately could be granted two patents, one that includes Group IV claims and another with claims directed to the Group VIII, which encompass claims of Group IV. If the claims to Group IV, issued first, a later issuing patent with Group VIII claims could not be held to constitute obvious-type double patenting over the earlier issuing patent, even though the Group IV claims are encompassed by Group VII claims. See MPEP 806, paragraph 3, which states:

[w]here inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct.

See, also MPEP 804.01, which states:

35 U.S.C. 121 authorizes the Commissioner to restrict the claims in a patent application to a single invention when independent and distinct inventions are presented for examination. The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. The prohibition does not apply where the divisional application was voluntarily filed by the applicant and not in response to an Office requirement for restriction. This



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apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

Therefore, restriction as between Group IV and Group VIII is improper.

Groups VIII and VI

Group VIII is directed to a method for producing a transgenic plant by introducing a SATAC into a plant cell; and producing a transgenic plant therefrom. Group VI is directed to a method for producing a transgenic plant by introducing SATAC into a plant cell. Group VI claims include the steps by which a SATAC can be made. Therefore, Group VI is directed to species of Group VIII in which the SATAC that is introduced in the plant cell is made by the steps specified in the claim. Thus, Group VIII and Group VI are related as a genus/species, and are not properly restrictable.

If the claims are restricted into these two groups, applicant ultimately could be granted two patents, one that includes Group VI claims and another with claims directed to the Group VIII, which encompass claims of Group VI. If the claims to Group VI, issued first, a later issuing patent with Group VIII claims could not be held to constitute obvious-type double patenting over the earlier issuing patent, even though the Group VI claims are encompassed by Group VII claims. See MPEP 806, paragraph 3, MPEP 804.01, and 35 U.S.C. 121, discussed above.

Conclusion

Since the Groups VI and VIII are not properly restrictable and Groups IV and VIII are not properly restrictable, Groups IV, VI and VIII should be examined in a single application.

Group II

The Examiner's attention is directed to MPEP §803.04. Restrictions to single nucleotide sequences are discussed in §803.04 of the Manual of Patent



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Examining Procedure (MPEP). According to MPEP §803.04, claims drawn to nucleotide sequences encoding different proteins are deemed properly restrictable, although the Commissioner has decided *sua sponte* to partially waive this requirement for a reasonable number (usually, ten) of patentably distinct sequences. MPEP §803.04 states:

Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patently indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

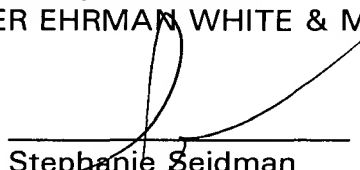
In this instance, each of SEQ ID Nos. 18-24 do not encode different proteins, but are portions of rRNA-encoding DNA, and thus are not independent.

* * *

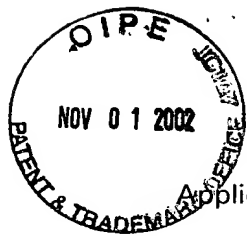
In view of the above amendments and remarks, reconsideration of the requirement for restriction and examination of the application are respectfully requested.

Respectfully submitted,
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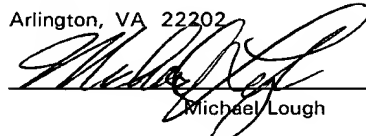
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Michael Lough

MARKED UP CLAIMS UNDER 37 C.F.R. §1.121

Please amend claims 50 and 58 as follows:

50. (Amended) A method for producing a transgenic plant, comprising
introducing a satellite artificial chromosome (SATAC) into a plant
protoplast; and
growing the protoplast cell under conditions to produce a transgenic
plant.

58. (Amended) A method of producing a transgenic plant, comprising:
introducing a DNA fragment into a first cell, wherein the DNA
fragment comprises a selectable marker;
growing the cell under selective conditions to produce cells that
have incorporated the DNA fragment into their genomic DNA; and
selecting a cell that comprises a satellite artificial chromosome
(SATAC); [and]
isolating the SATAC and introducing it into a plant cell; and
growing the plant cell under conditions to produce a transgenic
plant.